

REMARKS

In the Office Action, the Examiner indicated that claims 1 through 23 are pending in the application and the Examiner rejected all of the claims.

Claim Rejections, 35 U.S.C. §102

In items 3-6 on page 2 of the Office Action, the Examiner rejected claims 1,2,4-10, 12-19, and 21-23 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,408,278 to Carney et al. ("Carney").

Rejection of Claims 3, 11, and 20 under 35 U.S.C. §103(a)

On page 3 of the Office Action, the Examiner rejected claims 3, 11, and 20 under 35 U.S.C. §103(a) as being obvious in view of Carney.

The Present Invention

The present invention is directed to a method and system for providing targeted advertising to a group of individuals in public places or public carriers, such as trains, train stations, shopping malls, etc. Particularly, the demographics, purchasing history and/or personal preferences of individuals in a public place or carrier are collected, passively, from communication-enabled personal digital assistants (PDAs) or other communication-enabled wireless communication devices carried by individuals in the public place or public carrier. Preferably, this data is collected from communication-enabled PDAs carried by a group of individuals who are near an electronic display device for displaying advertisements to the

public. The collected data pertaining to the group of individuals is processed and used to select appropriate advertisements that would most likely interest those individuals. The selected advertisements are displayed immediately on the electronic display device located in the public place or public carrier so that they can be viewed by one or more of those individuals.

By obtaining the data passively from communication-enabled wireless devices, the individuals from whom the data is being obtained do not need to take any action, i.e., there is no need to push the data to the entity providing the advertising capability. Instead, the data is obtained via the communication-enabled wireless devices, which by their communication-enabled status, allow the advertising entity to pull the data from the wireless devices, often without the individuals even being aware that the data is being collected.

U.S. Patent No. 6,408,278 to Carney et al.

Carney teaches a system and method through which programming content is delivered for display on a network of electronic out-of-home display devices. Demographic data is obtained through a variety of means, and advertising is presented on the display devices based upon the demographic data. The demographic information associated with each display device can be changed based on predicted changes in the target audience as a function of time.

Data is gathered by, for example, the use of kiosks that provide audience members with access to the Internet in exchange for demographic information; through the use of a camera that captures an image of an audience at a given time and processes the image to determine the demographic makeup of the audience; the dispensing of free shopping bags in exchange for

demographic information, etc. Of particular relevance to the present examination is the gathering of demographic information based on the transfer of personal demographic information from passersby using cellular telephones, personal digital assistants, and credit cards, using cellular communications, radio frequency, infrared communications, and magnetic card readers.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

Applicant has amended the independent claims to expressly claim the passive nature of the collection of the group data, using communication-enabled wireless communication devices. These amendments focus the present invention on the pulling of the group data from the wireless devices present in the area, i.e., the people possessing the wireless devices do not take any action to "push" the demographic data to the advertiser. Applicant has recognized that many individuals utilize their PDA and other wireless devices in a "communication-enabled" mode whereby they are essentially "broadcasting" information, or making information available, at all times. Applicant uses this fact to pull demographic data from these communication-enabled devices.

Thus, unlike a kiosk, which requires a user to input the information actively (and which, in Carney, requires the giving of an award to the individual providing the data), the information is obtained passively with respect to the person carrying the wireless device. Further, unlike the data provided by travelers purchasing a ticket, which is typically limited to less personal information, such as name, gender, nationality, travel origin, travel destination, and credit card number, the present invention enables access to highly personalized data, such as an electronic business card, phone numbers, recent telephone history, favorite web sites, Web browsing history, and Web cookies. Other personal information such as shopping lists and "to-do" lists, as well as personal calendar information containing birthdays and anniversaries, is potentially made available using the present claimed invention.

Carney contains no teaching of the passive gathering of group data utilizing the communication-enabled capability of wireless communication devices. In every example in Carney, the user must push the data to the data gatherer. One such method of pushing the data to the data gatherer is through the use of cellular telephones, PDAs, and the like. However, nowhere in Carney does it teach or suggest the gathering of information from communication-enabled wireless devices, passively with respect to the possessor of the wireless device. Without such a teaching, Carney does not anticipate the present claims, as amended.

By providing access to the highly personal information of people via their communication-enabled wireless devices, applicant is able to target, with much more accuracy, advertising to individuals in the vicinity of an advertising medium. For example, applicant may be able to identify important dates, such as anniversaries or birthdays, from the

information available on the communication-enabled wireless device of an individual, and then present an advertisement reminding that person (or anyone else in the vicinity) to purchase flowers or a gift. Further, applicant may be able to identify personal spending information which identifies the individual as a big spender, and therefore might instead advertise a high-ticket item, such as a diamond ring, instead of flowers. These are but two simple examples of the benefit of having access to personal information using the present invention, information that is unavailable using the invention of Carney.

For the reasons set forth above, the present claimed invention is not anticipated by Carney. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Carney and are in condition for allowance.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

The Examiner relies upon Carney and the "well-known" nature of Bluetooth technology for concluding that claims 3, 11, and 20 are obvious in view of Carney. Applicant does not dispute that Bluetooth technology was well-known on the filing date of the present application, nor that Bluetooth technology was well-known as a means for facilitating communication among wireless devices. However, as set forth above, nothing in Carney teaches or suggests the pulling of data from communication-enabled wireless devices, passively with respect to a

possessor of the devices, to obtain access to, and the ability to use, highly specific and personal data stored on the wireless device. Without such a suggestion, Carney does not render the claimed invention obvious. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 3, 11, and 20 under 35 USC § 103.


Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

Enclosed herewith, in triplicate, is a Petition for extension of time to respond to the Examiner's Action, along with a Credit Card Authorization Form authorizing payment of the extension of time fee. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 19-5425.

Respectfully submitted

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Date


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